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530 7590 12/09/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER FADOK, MARK A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/677,153
Filing Date: October 02, 2000
Appellant(s): SCULLER ET AL.

Jeffrey S. Dickey
For Appellant

Supplemental Examiner's Answer

Pursuant to review of the examiner's answer mailed 8/14/2008 in view of the recent decision in *In re Bilski*, decision on appeal to the US Court of Appeals #2007-1130 decided 10/30/2008, the claims have been reconsidered **for rejection on the grounds of USC 101**, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below:

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This is in response to the appeal brief filed 10/9/2007 appealing from the Office action mailed 1/18/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

The claims were not finally rejected in the previous office action, but were rejected as a non-final (see rejection dated 1/18/2007).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

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The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 104,105,108-112 are directed to non-statutory subject matter. Based on Supreme Court precedence see *Diamond v Diehr* 450 US 175,184 (1981); *Parker v. Flook*, 437 US 584,588,n. 9 (1978); *Gottschalk v Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject matter (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

7,143,056	Lopez, Jr.	11-2006
6,631,375	Jecha et al	10-2003
6,650,433	Keane et al	11-2003

Official Notice

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

BEGIN NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 104,105,108-112 are directed to non-statutory subject matter. Based on Supreme Court precedence see *Diamond v Diehr* 450 US 175,184 (1981); *Parker v.*

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Flook, 437 US 584,588,n. 9 (1978); Gottschalk v Benson, 409 US 63, 70 (1972);

Cochrane v Deener, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject matter

(such as an article or materials) to a different state or thing. Since neither of these

requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

END NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 75-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez, Jr. (US 7,143,056) in view of Official Notice.

In regards to claims 75-77,80-89,92-94,96-97,99-112, Lopez, Jr. teaches all the features of the instant invention. For instance, method of obtaining information about a personalized product to be provided from a provider to an organization information provided by the organization, the personalized product displaying information provided by the organization (abstract).

the provider receiving login information identifying a first user within the organization (Fig 11);

Lopez, Jr. teaches defining the product layout and defining which fields may be changed (FIG 3 and 4) and having a first user log on to modify the fields (FIG 11 and 12, col 2, lines 45-55), but does not specifically mention that the initial product layout and defining of the fields is received over the internet from the first user. The examiner takes Official Notice that the use of the Internet to transfer information about product layout and fields which may be modified was old and well known in the art (design of websites). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Lopez, Jr. using the internet to design the product and define the modifiable fields, because this would allow the manufacturer to be at a remote location that may be less expensive for manufacture than their clients

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headquarters which may be in an a very expensive part of the country (Opelika, Alabama vs. New York City).

at least one aspect which may not be changed (col 2, lines 35-45);

receiving login information identifying the second user within the organization, wherein the login information of the second user is different from the login information of the first user (FIG 6);

transmitting to the second user over the network the values of aspects and an indication, in accordance with the instructions and based on the second user's login information (FIG 7),

distinguishing the aspects which the second user may change from those which the second user may not change (FIG 7); and

receiving from the second user over the network the value of an aspect which may be changed in accordance with the instructions and which has changed from the transmitted value (FIG 7).

In regards to claims 78,79 and 98, Lopez, Jr. teaches business cards and stationary, but does not specifically mention that the system is used for stamps and advertising specialties. The examiner takes Official Notice that producing products such as stamps and advertising specialties from printers was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Lopez, Jr. including additional products such as stamps and advertising products, because this would increase revenue and create a convenient one stop shop for a corporations needs.

In regards to claims 90, 91 and 95, Lopez, Jr. teaches identifying what information can be changed, but does not specifically mention that the information area has a three dimensional appearance of the area accepting the change. The examiner takes Official Notice that providing a three dimensional area indicating an area to be changed was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in art at the time of the invention to include in Lopez Jr. highlighting an area using three-dimensional representation, because this creates an efficient and easily recognizable means for guiding the user to the area which needs to be changed.

In regards to claims 78,79 and 98, Lopez, Jr. teaches business cards and stationary, but does not specifically mention that the system is used for stamps and advertising specialties. The examiner takes Official Notice that producing products such as stamps and advertising specialties from printers was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Lopez, Jr. including additional products such as stamps and advertising products, because this would increase revenue and create a convenient one stop shop for a corporations needs.

In regards to claims 90, 91 and 95, Lopez, Jr. teaches identifying what information can

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be changed, but does not specifically mention that the information area has a three dimensional appearance of the area accepting the change. The examiner takes Official Notice that providing a three dimensional area indicating an area to be changed was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in art at the time of the invention to include in Lopez Jr. highlighting an area using three-dimensional representation, because this creates an efficient and easily recognizable means for guiding the user to the area which needs to be changed.

(10) Response to Argument

In regards to applicant's lack of traversal of Official Notice in claims

78,79,98,90,91 and 95, a "traverse" is a denial of an opposing party's allegations of fact.

The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made.

Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231,234 (CCPA1971).

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If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71,60 USPQ 239 (CCPA 1943).

Appellant argues that that it is insufficient to base the rejection solely on features identified in an Official Notice. The examiner takes this to mean that applicant is asking for support for the taking of Official Notice after the taking of official Notice in a non-final rejection ("If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697" MPEP 2144.03). Further the examiner notes that appellant was cites that the area of art was the web site development art, the information available to an artisan of ordinary skill is well established and is not considered to be esoteric and is not considered to be specific knowledge but is generally known in the art. To support this assertion and in response to a request for specific cited art the examiner provides (US 6,631,375) to Jecha et al FIG 3, col 5, line 47 - col 9, line 22 and (US 6,650,433) FIG 4a-4ww and col 12, lines 44-65 as examples of art where business cards are designed over the internet using web pages.

In response to appellant's argument that there is no suggestion to combine Lopez with Official Notice the Quark tool is incompatible, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the

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prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, As is evidenced in the cited art to support official notice, Keane teaches the very use of the quark express to allow users with web design skill to develop there business cards over the internet.

Appellant argues that there are not two users in Lopez. The examiner disagrees and directs appellant's attention to Lopez col 7, line 63 to col 8, line 41 where it is clear that the Lopez identifies and permits an individual, separate from an employee, the authority to add and edit changes. Col 2, lines 18-55 further shows where the separate process of designing the card is separated from and employee ordering a specific card (see entry of company indicative information vs. user indicative information that may be changed by an employee). Further as stated supra, Official Notice teaches this first process of designing over the internet by a corporate employee (see (US 6,631,375) to Jecha et al FIG 3, col 5, line 47 - col 9, line 22 and (US 6,650,433) to Keane FIG 4a-4ww and col 12, lines 44-65).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., preventing other employees from changing the corporate logo of font size, but

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allowing other employees to change their employee identification number) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues that Lopez does not teach distinguishing the aspects which the second user may change from those which the second user may not change. The examiner disagrees and directs the appellants' attention to at least the "company indicative information" vs. "user indicative information" (see also claim 1, col 5, lines 20-45, col 6, lines 60-65, col 7, lines 25-30).

Appellant argues that Lopez does not teach "in accordance with instructions and based on a second user's logging information distinguishing the aspects which the second user may change from those that the second user may not change". As is clearly shown in FIGs 6, 10, 11, and 16 different log-ins are given different levels of input authority based on what log-in information is received.

Appellant argues that Lopez does not teach transmitting to the second user over the network values of aspects. The examiner disagrees and directs appellant to FIG 6 and 7 where it is clear that HTML pages are generated and transmitted to allow the entry of user specific information (col 6, lines 66-67).

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Appellant argues that Lopez does not teach distinguishing aspects which the second user may change from those that the second user may not change. The examiner disagrees and notes that when the second user is logging into the system of Lopez, the user obviously knows that they are ordering a business card and what a business card looks like, the second user is only provided an indication of what may be changed when the system provides a page for input in response to the login information. Entry is limited to specific approved information and other information such as font, location of information and company indicative information are available for change by the second user.

Appellant argues that Lopez does not teach the users are in the same organization. The examiner disagrees and directs the appellant's attention to Lopez col 5, lines 50-67, where it is clear that the company has authority over what is placed in the company-indicative fields and the user (personnel/employee) may only change the information in the user indicative field.

In regards to claims 96 and 103, appellant argues Lopez and Official Notice does not teach receiving instructions from the client to change whether the aspect is locked or unlocked. As is clearly depicted in the FIG 11,12 and col 8, lines 15-40, the purchasing agent has the authority based on their login to add, edit or remove titles when a function is selected from an interface adapted for operation over the world wide web (col 2, lines 55-65) utilizing HTML (interface) pages (col 6, lines 64-67). As is stated

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in appellant's specification this locking and unlocking feature is used to prevent previously entered information from being changed in order to prevent inadvertent errors (specification page 31, lines 1-4), this is by definition an edit function. As is clear in Lopez a function must be selected and transmitted to the server item 97 (unlocking when selecting the edit function, Jecha FIG 4d and col 7, lines 65-67, show an example of this type of functionality where an edit button is activated to retrieve the web page needed to permit the edit to the company protected information of a business card), before a page is sent back permitting the editing of the items that may be changed by users authorized to edit information in fields previously approved by a company authorized representative.

The examiner offers the following definitions to further clarify the disclosure of Lopez:

HTML Page -HTML page is equivalent to a web page.

Edit - Editing programs typically provide safeguards against inadvertent changes, such as by requesting confirmation before saving under an existing filename, by allowing the user to assign a password to a file or by giving the option of setting the file to read only status.

In regards to claim 104, Appellant argues that Lopez does not teach "receiving an instruction from a second user to unlock a locked aspect; resending the value of the prior locked aspect to the second user with an indication that the value may now be

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changed". As discussed supra, Lopez and Jecha or Kearne teach establishing by a first user (Lopez FIG 3 in conjunction with Official Notice (first locking function by authorized company representative that first sets up the protocol for permitting changes to select portions of the business card based on a identifier)) what may and may not be changed on a business card order. Lopez further gives a second user (authorized company user) the right to request the edit function from the server so that a locked item may be changed (unlock).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

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Respectfully submitted,

/Mark Fadok/

Primary Examiner, Art Unit 3625



Wynn Coggins

Director TC 3600

WYNN W. COGGINS
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